PATENT APPLICATION

RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2131

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

James D. THORNTON et al.	Group Art Unit: 2131
Application No.: 08/976,579	Examiner: A. Di Lorenzo
Filed: November 24, 1997	Docket No.: JAO 34191

For: PAPER DOCUMENT SATCHELS

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

In reply to the Office Action mailed February 13, 2002, reconsideration of the above-identified application is respectfully requested. Claims 1-28 remain pending in this application.

The Office Action rejects claims 1-28 under 35 U.S.C. §103(a) as being unpatentable over Zdybel (U.S. Patent No. 5,486,686) in view of Durbin (U.S. Patent No. 5,414,251). Applicants respectfully traverse the rejection.

In particular, Applicant asserts that neither Zdybel or Durbin, either alone or in combination, disclose or suggest a system for producing and processing a paper document, having at least a token generator that generates user-selectable tokens, and a selector that allows a user to select one or more decoded tokens from a list of decoded tokens, a recited in independent claim 1, and similarly recited in independent claims 10, 19 and 28.

Zdybel discloses an electronic document processing system that can couple hard copy

outputs to an electronic document from which a human readable hard copy is produced. See

column 1, lines 11-15. Zdybel enables data which is potentially important to the accuracy

and/or completeness of the reconstruction of the electronic source document 32 to be

recovered, even if such data is not evident or inferable from the appearance of the human

readable rendering of the source document. See column 10, lines 7-27. The system can be

utilized for storing and communicating a machine readable description of all or any selected

part of the electronic source document 32, as well as descriptions of the equipment and

process employed for producing the source document 32 and the human readable rendering

45. See column 10, lines 40-45. Documents can be printed to include digitally embedded

data descriptions and can be distributed by mail. See column 10, lines 55-60.

Durbin discloses a scanner for reading optical information sets. See column 2, lines

16-18. Rectangular areas within a displayed area may be highlighted to indicate to a user

which areas are probable bar codes, and may annunciate that bar code symbol, or portion

thereof, which the microprocessor 26 is currently attempting to decode. See column 4, lines

55-61.

The user views the display 28 of the bar codes, moves the reader 10 and zooms as

necessary as a desired bar code symbol 20 comes into view. See column 5, lines 35-50 and

figure 2. The reader 10 continues to show the viewed field in the display 10 even as it

decodes the bar code symbol 20. Only one bar code can be selected to be decoded from a

page containing many adjacent bar codes that have not been decoded.

A microprocessor 26 in Durbin can utilize pattern recognition techniques to locate

rectangular shapes (or other information *encoded* shapes) which might be *decodable* bar code

symbols. See col. 4, lines 23-44. Then the microprocessor may make an attempt to *decode*

the contents within the highlighted bar code symbol. Then, if the decode was successful, the user may either accept or reject the decoded data.

In stark contrast to Applicant's claimed invention, neither Zdybel nor Durbin disclose or suggest a selector that allows a user to select one or more <u>decoded</u> tokens from a list of <u>decoded</u> tokens. On the contrary, Durbin clearly shows that the display on the reading device displays barcodes that have <u>not</u> been decoded, and remain in an <u>encoded</u> state as defined by Durbin. Then, a user can auto focus and zoom on to one desired barcode symbol so that the one desired barcode symbol can be decoded. However, there is no list of decoded tokens in Durbin in which a user can select on or more decoded tokens.

The Office Action indicates that the Applicant's Specification makes no mention of what it means to decode tokens, only that the segmentor/token decoder 370 decodes the tokens. Furthermore, the Office Action indicates that no mention has been made of any definition of the term "decoded." Thus, the Office action applies various dictionary definitions of the term "decode" to conclude that the term can mean "converting analog information (the printed barcode) into digital information (digital representations of the printed tokens)."

Applicant respectfully asserts that the definition of "decode" as applied by the Office Action is an incorrect interpretation of the term "decode" used in the Applicant's claim language.

Specifically, Applicant respectfully points out to the Examiner that the Applicant's Specification clearly defines how a token is generated, *encoded* and printed on paper, and how the encoded token can include numerous types of data, i.e., a *list* of references, documents, services, programs, etc. See Specification, page 6, line 34 - page 7, line 21.

Thus, one skilled in the art could easily conclude that the list of decoded tokens, as recited in independent claim 1, 10, 19 and 28, can therefore include a decoded *list* of

references, documents, services, programs, etc., that were originally encoded into the token, which can be provided to the user so that the user can <u>select</u> one or more decoded tokens from a list of the decoded tokens.

In contrast, the display in Durbin that displays coded barcodes does not display a list of decoded tokens to show this type of information. In fact, Durbin clearly defines the barcodes in the display as *decodable* bar code symbols. Thus, Durbin fails to disclose a selector that allows a user to select one or more <u>decoded</u> tokens from a list of <u>decoded</u> tokens, and instead clearly discloses that the barcodes that are displayed are <u>not</u> decoded as defined by Durbin.
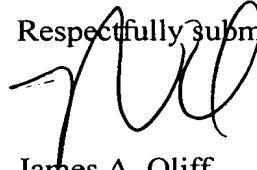
Finally, Applicant asserts that there would have been no motivation to combine Durbin with Zdybel because Durbin is concerned with providing a more sophisticated apparatus that can decode two-dimensional barcode symbols which include information along the vertical axis so that database retrieval is <u>not</u> required. See col. 1, lines 27-55. Thus, Durbin teaches away from using a token which points to, for example, a reference document that may be located in another location.

Accordingly, because Durbin fails to compensate for the deficiencies in Zdybel, Applicants assert that it would not have been obvious to combine the references to arrive at the Applicants' claimed invention. Thus, Applicants assert that independent claims 1, 10, 19 and 28 define patentable subject matter. Claims 2-9, 11-18 and 20-27 depend from claims 1, 10 and 19 and therefore also define patentable subject matter. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. §103(a) be withdrawn.

In view of the above remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-28 are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Richard S. Elias
Registration No. 48,806

JAO:RSE/ala

Date: March 27, 2002

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 24-0037